REMARKS

Claims 1-20 and 31-60 are pending in the application. Claims 8-20, 32-34, 36-40, 47-48 and 55-60 have been withdrawn. The Examiner has rejected claims 1-7, 31, 35, 41-46 and 49-54 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over co-pending application no. 10/613,414. The Examiner states that USSN 10/613,414 teaches the generic compounds and compositions which are similar to the claimed compounds of the present application, thus one skilled in the art would be motivated to choose to replace variable substitutions in core heterocyclic ring in view of the known teaching of the art. Thus, he concludes that in the absence of any unobviousness or unexpected properties, the compounds are so closely related structurally to the homologous and/or analogous compounds of the cited art as to be structurally obvious.

Obviousness-type double patenting prohibits "the issuance of the claims in a second patent not patentably distinct from the claims of the first patent." In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1992). This type of double patenting occurs when a patent's claim(s) are "merely an obvious variation" of the other patent claim. See In Re Goodman, 11 F.3d 1046, 1052 (Fed. Cir. 1993); Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326 (Fed. Cir. 1999) ("Under obviousness-type double patenting, a patent is invalid when it is merely an obvious variation of an invention disclosed and claimed in an earlier patent by the same inventor").

An obviousness-type double patenting analysis entails two steps. First, the court construes the claims in the relevant patents and second it identifies the

differences in the subject matter between the two claims and determines whether the subject matter is patentably distinct. Eli Lilly & Co. v. Barr Labs., 251 F.3d 955, at 968 (Fed. Cir. 2001). (internal citations omitted); See, also General Foods Corp., 972 F.2d at 1278, 23 USPQ 2d at 1843-44; and In re Kaplan, 789 F.2d at 1577, 229 USPQ at 683.

The principle that an earlier genus patent does not necessarily render obvious a subsequent claim to a species of the genus is well-grounded in the law of double patenting. See In re Baird, 16 F.3d 380, 29 USPQ 2d 1550 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."). Further, where there is a large genus in a patent, it is submitted that, in the absence of direction to a smaller portion thereof, the smaller portion is not obvious. In re Jones, 958 F.2d 347, 21 USPQ 1941 (Fed. Cir. 1992).

The claims of the '414 patent application have been amended so that Z is S, -CH, and CH_2. The claims of the present application define S as follows:

> "Z represents NR^b, where R^b is hydrogen, or substituted or unsubstituted $(C_1\text{-}C_6)$alkyl, $(C_2\text{-}C_6)$alkenyl, $(C_3\text{-}C_6)$cycloalkyl, $(C_1\text{-}C_6)$alkoxy, aryl, aralkyl, aryloxy, $(C_1\text{-}C_6)$alkylcarbonyl, arylcarbonyl, $(C_1\text{-}C_6)$ alkoxycarbonyl and aryloxycarbonyl;"

In conclusion, the compounds of the present application are not obvious over the compounds of the '414 application Therefore, the obviousness-type double patenting is deemed to be improper and Applicants request that this rejection be withdrawn.

In view of the foregoing remarks, Applicants submits that the pending claims particularly define and patentably distinguish the invention over the art of record, and request that the Rejection be withdrawn and that this case is passed to issuance. Applicant is filing a response to and amendment the '414 application on December 22, 2005 and will provide the Examiner with a copy of said response and amendment. Should the Office believe that further issues remain to be resolved it is requested that she telephone the undersigned in order to provide the Applicants with an opportunity to resolve such issues.

Respectfully submitted,

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